

REMARKS/ARGUMENTS

Status of the Claims

Claims 1-13, 15-21, and 23-24 are currently pending in the application. Claim 1 has been amended. Claims 15-18 have been cancelled. No claims have been added. Claims 1 and 19 are independent claims.

Prior to entry of this amendment, the application included claims. In a final office action mailed August 6, 2008, claims 1-13 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,089,208 B1 to Levchin et al. ("**Levchin**") in view of U.S. Patent No. 7,287,009 B1 issued to Liebermann ("**Liebermann**"). Claims 15-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Levchin in view of U.S. Patent No. 6,631,358 B1 to Ogilvie ("**Ogilvie**"). Claims 19-21 and 23-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Levchin in view of Liebermann, and further in view of Ogilvie.

Claim Rejection Under 35 U.S.C. § 112

Claims 1-13 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 has been amended to obviate the lack of antecedent basis. Applicants respectfully request the Examiner to withdraw this rejection.

Claim Rejection Under 35 U.S.C. § 103, Levchin in view of Liebermann

Claims 1-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Levchin in view of Liebermann. Applicants respectfully request reconsideration of the rejection because the Examiner has failed to show a *prima facie* case of obviousness. An obviousness rejection under 35 U.S.C. § 103(a) must use prior art available under one or more sections of

35 U.S.C. § 102. *See* MPEP § 2141.01. The Examiner has cited sections of Liebermann. *See Office Action*, p. 4. Liebermann is available as prior art only under 35 U.S.C. § 102(e) because Liebermann was not published and issued after the filing date of the present application.

35 U.S.C. § 102(e) states:

A person shall be entitled to a patent unless — . . .

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; . . .

Liebermann cannot be considered prior art under 35 U.S.C. § 102(e) because Liebermann was not filed before the invention of the present application.

Liebermann has a filing date of September 14, 2000. The present application (hereinafter the “Application”) clearly claims benefit to the filing dates of two different applications. *See Application*, p. 1, lines 2-4. First, the Application claims priority to PCT/US01/22,179 that was filed on July 11, 2001. The Application also claims priority to U.S. Patent Application No. 09/613,615 filed on July 11, 2000. For purposes of examination, the earliest priority date of the Application is considered the date of invention. *See* MPEP § 2136.05. As such, the Application has an invention date that is earlier than that of Liebermann. Indeed, the priority date of the Application is July 11, 2000 which predates the filing date of Liebermann, September 14, 2000 by a few months. Therefore, Liebermann cannot be prior art under 35 U.S.C. § 102(e) because the filing date of Liebermann does not precede the priority date of the Application.

The support for claim elements rejected using Liebermann, notably, “transferring money from one account to another by debiting a customer’s account and placing monies into a

temporary account,” and moving the money “from the temporary account to he account of the recipient,” is found in the priority document. Applicants wish to draw the Examiner’s attention to U.S. Pat. No. 7,376,587 that issued from U.S. Patent Application No. 09/613,615. The supporting disclosure can be found at least at col. 5, line 39 – col. 6, line 36. As such, the claim should be accorded the filing date of U.S. Patent Application No. 09/613,615, July 11, 2000. Thus, Liebermann is not prior art.

Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. § 103(1) as it applies to all claims and issue a notice of allowance at the earliest convenience.

Claims 2-13:

Claims 2-13 all depend, either directly or indirectly, from allowable claim 1. Therefore, claims 2-13 are allowable over the cited art due, at least in part, to this dependence on an allowable independent claim.

Claim Rejection Under 35 U.S.C. 103, Levchin in view of Ogilvie

Claims 15-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Levchin in view of Ogilvie. Claims 15-18 have been cancelled, and this rejection is now moot.

Claim Rejection Under 35 U.S.C. 103, Levchin in view of Liebermann and Ogilvie

Claims 19-21 and 23-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Levchin in view of Liebermann, and further in view of Ogilvie.

Claims 19:

Claims 19 includes similar limitations as those mention with claim 1. Therefore, for the same or similar reasons, claim 19 is also allowable over the cited art.

Appl. No. 10/046,654
Amdt. dated October 6, 2008
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 3691

PATENT

Claims 20-21 and 23-24:

Claims 20-21 and 23-24 all depend from allowable claim 19. Therefore, claims 20-21 and 23-24 are allowable over the cited art due, at least in part, to this dependence on an allowable independent claim.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested. Applicants do not acquiesce to any argument not specifically addressed herein. Rather, Applicants believe that all arguments and rejections are addressed by the amendments and arguments presented herein.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Tadd F. Wilson
Reg. No. 54,544

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
T3W:s5s/slb
61477275 v1